

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-2, 4-5, and 7-8 are rejected under 35 U.S.C. 103 (a) as being unpatentable over the Mansour, et al reference in view of the Nahrestedt reference, and further in view of the Campanella, et al reference.

Claim 6 is rejected under 35 U.S.C. 103 as above, and further in view of the Lou reference.

Also, the claims are objected to and rejected under 35 U.S.C. 112.

In regard to the Examiner's grounds for formal objections and rejections, the Examiner's helpful suggestions have been gratefully appreciated. In connection with this, the corresponding claims have been amended as proposed by the Examiner.

It is believed that the Examiner's grounds for the objections and rejections are therefore no longer tenable and should be withdrawn.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, it is respectfully submitted that the present invention as defined in the claims clearly and patentably distinguishes from the prior art.

The Mansour reference discloses a multistream in-band on-channel system. The invention disclosed in this reference may be utilized with any desired types of channels. However, the channels in this reference are subbands. It is not disclosed that these channels are independent of each other. The Mansour reference only discloses AM or FM carriers with different subcarriers. Also, in the Mansour reference only subband and adjacent channel interference are regarded, as explained for example in column 4, lines 17, 18-36 so that the channels disclosed here could not be independent from each other.

It is believed that from the disclosure of this reference it is not justifiable to interpret the term "channel" in a way different from the whole context of this reference. Keeping this in mind, a person of ordinary skill in the art would never have thought about combinations of this reference with the Nahrstedt or Campanella references, because the channels disclosed in the Campanella reference are also not independent from each other. They are multiplexed in the same frame and multiplexed on a common carrier frequency.

In contrast, in the applicants' invention the channels are broadcast channels with independent carriers. None of the references suggests such a

system. Any theoretical combinations of the above listed references would make no sense and it definitely would not be possible to arrive at the applicants' invention from the references taken singly or from their combination.

In order to arrive at the applicants' invention from the references, it is not sufficient to combine the references, but the references have to be fundamentally modified by including into them the new features of the present invention which are now defined in the independent claims in the present application and were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

It should be also mentioned that with the independent channels the problems of signaling arises. This has been solved in the applicants' invention by incorporating a signaling in the main data stream which indicates whether an auxiliary data stream is provided for the same useful signal source, and in what channel it is provided. This feature is specifically defined in the independent claims. This signaling is completely different from the signaling disclosed in the

Campanella reference. The Campanella reference discloses a service control header together with the content indicator relating to the content of the auxiliary field. All these informations are in the same frame and belong together, and are decoded together in a single decoding unit. These informations therefore can not belong to independent (broadcast) channels decoded in different units.

In view of the above presented remarks and amendments, it is believed that claims 1, 2, 7, and 8 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the corresponding independent claims, and they share their features, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should

the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker
Attorney for Applicant
Reg. No. 27233